

REMARKS

This paper is presented in response to the non-final official action dated October 24, 2008, wherein (a) claims 1-3, 5-13, and 15-19 were pending, (b) claims 1-3, 5-13, and 15-19 were rejected as indefinite, (c) claims 1-3, 5, 9-13, 17-19 were rejected as obvious over Boersma U.S. 2003/0052038 A1 ("Boersma") in view of Allen U.S. 5,381,892 ("Allen"), (d) claim 6 was rejected as obvious over Boersma in view of Allen and further in view of Rose U.S. 6,119,929 ("Rose"), (e) claims 7, 8, 15, and 17 were rejected as obvious over Boersma in view of Allen and further in view of Lochmiller U.S. 4,383,609 ("Lochmiller"), and (f) claims 2, 3, 11, and 12 were rejected as obvious over Boersma in view of Allen and further in view of Barnes et al. U.S. 3,968,895 ("Barnes").

By the foregoing, claims 1, 10, and 18 have been amended to overcome the indefiniteness rejections only and not for patentability reasons, and new claim 20 has been added. Support for the amendments to claims 1, 10, and 18 and for new claim 20 may be found in the specification and claims as originally filed. For example, support for the amendment to claim 1 and new claim 20 may be found at least at page 1, lines 30-32 and page 3, lines 18-30 of the specification as originally filed. No new matter is added.

As a result of the foregoing, claims 1-3, 5-13, and 15-20 are pending.

Reconsideration of the application, as amended, is solicited.

The issues raised in the action are addressed below in the order appearing in the action.

Indefiniteness

The amendments to claims 1, 10, and 18 address the indefiniteness rejections under 35 U.S.C. § 112. In particular, claim 1 is amended to remove the alleged indefinite term "with different numbers of side walls." Claim 10 is amended to depend from claim 17 and now has proper antecedent basis for "the cover." Claim 18 is amended to remove the alleged narrow range limitation of "freight boxes." Applicants respectfully submit that the amendments to claims 1, 10, and 18 have

overcome the indefiniteness rejections. Reconsideration and withdrawal of the indefiniteness rejections is therefore solicited.

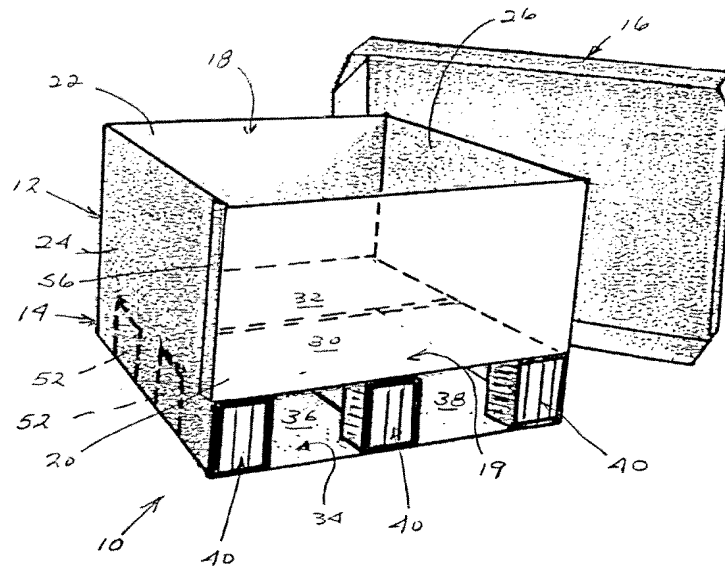
Obviousness

Applicants respectfully traverse the rejection of claims 1-3, 5-13, and 15-19 as obvious over Boersma in view of Allen and any one of Rose, Lochmiller, and Barnes et al. One of ordinary skill in the art would not modify the teachings of Boersma with the teachings of Allen to arrive at the claimed container because modifying Boersma as alleged would render Boersma unsuitable for its intended purpose. Alternatively, the modified Boersma container would fail to meet all claim limitations. As all of the rejections are based on the teachings of Boersma as modified by the teachings of Allen, Applicants respectfully submit that the official action has failed to establish a *prima facie* case of obviousness because there is no motivation to combine the teachings and because the modified Boersma disclosure would fail to disclose or suggest all claim limitations.

Applicants agree that Boersma fails to disclose or suggest a container having sidewalls with an open base. See the official action at page 4. The official action relies on Allen to teach a container having an open base. However, the official action fails to take into account that the alleged modification to Boersma would render Boersma unsuitable for its intended purpose. Therefore, there can be no motivation to modify the teachings of Boersma and the official action has failed to establish a *prima facie* case of obviousness. "If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984); See also M.P.E.P. § 2143.01(V).

Boersma teaches a corrugated container including an upper storage compartment 12 and a lower pallet compartment 14. The storage compartment 12 includes opposed end panels 20, 22, and opposed side panels 24, 26. "End panels 20 extend downwardly from the open top 18 of the container to the bottom 19 of the storage compartment." See Boersma paragraph [0025] and Fig. 1 of Boersma reproduced below.

FIG. 1



The bottom 19 separates the storage compartment 12 from the pallet compartment 14. The proposed modification to Boersma (i.e., to remove the bottom 19 thereby allegedly creating an open base in the sidewalls) would eliminate the separation between the storage compartment 12 and the pallet compartment 14 thereby causing any items stored in the Boersma container to fall through the storage compartment 12 and into the pallet compartment 14. At the very least any items falling into the pallet compartment 14 could be subject to damage by the tines of a forklift when the container 10 was moved. Moreover, items falling into the pallet compartment 14 would likely fall out of the container entirely by rolling or sliding out of the space between the stacking blocks 40.

One of the primary objects of Boersma is to “provide an improved recyclable corrugated container that incorporates its own corrugated pallet or skid.” *Id.* at paragraph [0005]. Removing the bottom 19 of the Boersma container, as suggested in the official action, would render Boersma unsuitable as a container as items in the container would be subject to damage and loss if the bottom 19 were removed. Thus, one skilled in the art would not be motivated to make the proposed modification. As a result, the official action fails to establish a *prima facie* case of

obviousness. For this reason, Applicants respectfully request withdrawal of the rejection of claims 1-3, 5-13, and 15-19.

Even if there were motivation to make the alleged modification to Boersma, the modified Boersma container would fail to disclose or suggest all claim limitations. In particular, the modified Boersma container would fail to disclose or suggest "a pallet with a **planar and solid top**" (emphasis added) as is recited by pending claim 1. In particular, removal of the bottom 19 to give the Boersma container sidewalls with an open base, as suggested in the official action, would result in the pallet section 14 of the Boersma container having no top at all, or at best, having only the tops of the stacking blocks 40. The tops of the stacking blocks 40 cannot be considered to make a pallet top that is "planar and solid" as is recited by pending claim 1. Thus, the modified Boersma container fails to meet all claim limitations and the official action fails to make a *prima facie* case of obviousness. For this additional reason, Applicants respectfully request withdrawal of the rejection of claims 1-3, 5-13, and 15-19.

Conclusion

For all the foregoing reasons, it is submitted that all claims 1-3, 5-13, and 15-20 are of proper form and scope for allowance, and such action is solicited.

Should the examiner wish to discuss the foregoing or any matter of form in an effort to advance this application toward allowance, he is urged to telephone the undersigned at the indicated number.

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Respectfully submitted,

By 

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